



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/771,454 | 02/05/2004 | Alberto Nicoletti | 108910-00121 | 2955 |

4372 7590 07/06/2005

ARENT FOX PLLC
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

| |
|----------|
| EXAMINER |
|----------|

COONEY, JOHN M

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1711

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,454

Applicant(s)

NICOLETTI ET AL.

Examiner

John m. Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2 shts.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Objections

Claims 2-3 are objected to because of the following informalities: Claim 2 and 3 set forth ratios (for example, 0.005 to 0.1) which should be corrected for clarity (for example – “0.005 to 0.1” should be changed to “0.005 to 0.1 : 1” to avoid confusion that the ratio is “0.005 : 0.1”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1.) Applicants' employ commas between the individual recitations of R' and R elements of their claims {i.e. the molecular unit structures}. There is no indication whether these are alternative embodiments as would be indicated by the term “or” or another intended meaning. Accordingly, the claims are confusing as to intent.

Similarly, the recitations “n0 is equal to 0,1” and “R,R” render the claims confusing as to intent.

(2.) Applicants' employment of the language “when possible” in line 15 of claim 1 is confusing as to intent because it can not be determined what degree of a limitation is being set forth by this recitation.

(3.) Applicants' set forth recitations defining their component R_f which are marked by “-”s. However, these hyphenated recitations appear to be referring to alternative embodiments {i.e. when R_f is “linear or branched” and when R_f is a “perfluoropolyoxyalkylene”, as well as other possible embodiments, while no clear indication is being set forth where separations between alternative embodiments may be. Accordingly, it can not be determined whether R_f is being defined to require all of the elements recited or not, and/or what degree in between, and the claims, therefore, are confusing as to intent.

(4.) When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner (selected from the group “consisting of” A,B, and C) or alternatively (selected from A, B, or C). See M.P.E.P. 706.03(y). Claims 1 and 6-12 recite numerous Markush groups which are improper.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims to “use” are impermissible in U.S. practice. Amendment to “method of using” appears expedient.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kruecke et al.(6,080,799) in view of Moore et al.(5,658,962).

Kruecke et al. discloses preparations of polyurethane foams prepared from blowing agent combinations of 1,1,1,3,3-pentafluorobutane, and/or other hydrofluorocarbons, and/or other blowing agents as desired (see column 3 lines 45-53, as well as, the entire document).

Kruecke et al. differs from applicants' claims in that hydrofluoroalkyl ethers and/or other hydrofluoro-compounds as claimed by applicants are not particularly required. However, Moore et al. discloses these compounds to be useful in polymeric foam preparations for the purpose of imparting acceptable foaming effects (see column 4 lines 10-12, and column 23, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have been obvious for one having ordinary skill in the art to have employed the blowing agents of Moore et al. in the preparations of Kruecke et al. for the purpose of imparting their acceptable blowing and cell regulating effect in order to arrive at the products and/or processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kruecke et al.(6,638,275) in view of Klug et al.(5,605,882).

Kruecke et al. discloses preparations of polyurethane foams prepared from blowing agent combinations of 1,1,1,3,3-pentafluorobutane, and/or other hydrofluorocarbons, and/or other blowing agents as desired (see the entire document).

Kruecke et al. differs from applicants' claims in that hydrofluoroalkyl ethers and/or other hydrofluoro-compounds as claimed by applicants are not particularly required. However, Klug et al. discloses these compounds to be useful in polymeric foam preparations for the purpose of imparting acceptable foaming effects (see the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have been obvious for one having ordinary skill in the art to have employed the blowing agents of Klug et al. in the preparations of Kruecke et al. for the purpose of imparting their acceptable blowing and cell regulating effect in order to arrive at the products and/or processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Selman et al.('875), Doerge et al.('808), Stevenson('056), Owens et al.('673), and Moore et al.('253) & (2001/0027172) are all recited for their disclosures of relevant materials in the art.

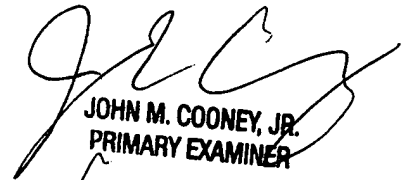
Application/Control Number: 10/771,454
Art Unit: 1711

Page 6

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700